

AUG 31 2010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF TRANSMISSION

I hereby certify that I am transmitting this correspondence to the Commissioner for Patents at the United States Patent and Trademark Office by telephone facsimile to telephone number (571) 273-8300 on Aug 26, 2010.

By: J. Michael Neary - Aug. 31, 2010
Michael Neary Date: Aug 31, 2010

Inventor(s): Gerald J. Julien)
Serial No.: 10/505,356) Group A.U. 3818
Filing Date: August 19, 2004) Examiner: John Daniel Walters
Title: Nitinol Ice Blades)

Information Disclosure Statement

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Aug 31, 2010

Sir:

Applicant's attorney has just discovered that the Report on the performance of Nitinol ice skate blades prepared by Dr. Alain S. Comtois of the Department of Kinanthropology at the University of Quebec in Montreal, and Francois Whittom and Olivier Desmeules of Whittom and Associates Sports-Performance-Technologies and submitted in this application with a response on Aug. 1, 2008, was published on May 2009 in Volume 41, Issue 6 on page 127 of Medicine & Science in Sports & Exercise, the official journal of the American College of Sports Medicine. This article is also available on-line at <http://journals.lww.com/acsm-msse/Fulltext/2009/05001/Ice-Hockey-Players-Speed-Improved-Bv-A.11>.

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CENTRAL FAX CENTER**AUG 31 2010****Remarks**

On Aug. 1, 2008, Applicant transmitted a Report on the performance of Nitinol ice skate blades prepared by Dr. Alain S. Comtois of the Department of Kinanthropology at the University of Quebec in Montreal, and Francois Whittom and Olivier Desmeules of Whittom and Associates Sports-Performance-Technologies. This report was commissioned by Triumph Sports, licensee of this application.

This Report provides additional objective evidence of patentability of the claims in this application. It proves the superiority of Nitinol skate blades over regular state-of-the-art steel blades in terms of speed and maneuverability on the ice. These characteristics were not recognized by experts in the art before Applicant made his invention, and indeed were not recognized by experts in the art even after Applicant's licensee provided test blades to the experts for testing. The experts were so certain of their "knowledge" about the characteristics of a skate blade that they believed that the Nitinol skate blade, which apparently lacked these "essential" characteristics, would be inferior, and evidence to the contrary could not convince them otherwise. This actual evidence of what experts in the art thought about the invention, even after it was explained to them and demonstrated with actual test samples, is overwhelming evidence of the patentability of the invention. This situation is thoroughly detailed in the Declaration of Susan Buchanan, of record in this application.

The Report submitted on Aug. 1, 2008, presented the startling and unexpected fact that Type 60 Nitinol skate blades were significantly faster on the ice than steel blades. Speed on the ice is a profoundly important property in most skating applications. For example, speed skating competitions are often won by mere seconds or fractions of a second. A speed advantage of 2-5% (which the Report documents) would be an overwhelming benefit to a competitor in a speed skating contest. It is also significant in ice hockey, as the Report explains. This is an extremely important fact relating to patentability, but the Examiner has declined to "official consider" the Report because it was not published or submitted as a Rule 132 Declaration.

Now Applicant's attorney has found a shorter version of this Report in a publication, and also on the internet. Thus, it should now be worthy of "official consideration" by the Examiner.

The Examiner states in the outstanding Office Action that the Report needs to compare the inventive skate blades with Abkowitz skate blades to be "applicable". Applicant respectfully disagrees. Applicant would love to compare his blades to Abkowitz blades and would do so if Abkowitz blades were available. Moreover, the Report is "applicable" because it shows an unexpected superiority of Applicant's blades that a person of ordinary skill in the art would not have expected to obtain. Thus, even if a person of ordinary skill in the art were to ignore all the knowledge and experience he had painfully learned about titanium alloy blades and believed every contrary suggestion he read in Abkowitz, he still would not have any reason to expect the superior performance that Type 60 Nitinol blades could provide.

Accordingly, Applicant believes that the claims in this application do define subject matter that is patentable over the prior art and respectfully requests the Board to reverse the Examiner's rejection and to remand this application back to him for issue.

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Respectfully submitted,


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